Application No.: 09/591,307
Amendment dated September 18, 2003
Reply to Advisory action of October 17, 2003

Remarks/Arguments

Summary of the Prosecution History

In the first action on the merits, the Examiner rejected all claims as being obvious over Maa et al. (US Patent No. 6,284,282). In response to the Office action, Applicants amended the claims and added new claims. In the second (final) Office action, mailed May 13, 2003, the Examiner rejected Claims 1-45, 47 and 49-51 over Maa et al. Claims 46 and 48 were not rejected over Maa et al. In the Amendment after Final Rejection mailed on September 25, 2003, Claims 1 and 20 have been amended to include the limitations of Claims 46 and 48, respectively. Claims 46 and 48 were canceled. *Because Claims 46 and 48 were not rejected, this amendment should have clearly placed the application in condition for allowance.* In the Advisory Action mailed on October 17, 2003, all claims have been rejected.

New Ground of Rejection in an Advisory Action is Improper

The Examiner's maintenance of the rejection in the Advisory Action is procedurally improper. These claims were not rejected on this ground in the Final Office Action. Thus, the rejection in the Advisory action is a new ground of rejection and is procedurally improper. Compare with MPEP 706.07(a). Withdrawal of the finality of the Office action is respectfully requested.

Rejection under 35 USC 103

The Examiner now rejects these claims over US Patent 6,284,282 to Maa *et al.* ("Maa").

The claims, as amended, require, among other things, that at least about 75% of the particles stored in the receptacle have a fine particle fraction (FPF) less than 6.8 microns and at least about 50% of the mass within the receptacles is delivered to the patient.

Maa et al. also teach pulmonary delivery of drugs to mammals. It teaches that FPFs that exceed 10%, preferably between 40-50%, are desirable. The total amount actually

delivered to the mammal is not disclosed. The Examiner reasons that, since Maa et al. teach that at least 10% of the powder is preferably delivered, the invention is generically disclosed. Nonetheless, Maa et al. do not teach that such high efficiencies can be achieved nor does it teach how one may achieve them. Indeed, even the generic disclosure is insufficient to render the present claims obvious. Indeed, it is believed that this is the very reason the Examiner did not reject Claims 46 and 48 in the Final Office Action. Hence, incorporation of the limitation of these allowable claims into Claims 1 and 20 should render all of the claims allowable. Withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,
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